

## **REMARKS/ARGUMENTS**

The Applicant originally submitted Claims 1-21 in the application. Presently, the Applicant has amended Claims 1-4, 6, 8-11, 13, 15-18 and 20. No claims have been canceled or added. Accordingly, Claims 1-21 are currently pending in the application.

### **I. Rejection of Claims 1-21 under 35 U.S.C. §112**

The Examiner has rejected Claims 1-21 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner has rejected independent Claims 1, 8 and 15 for containing the phrase "wherein said party identification information includes a call-back number identified from a priority list." While the Applicant strongly disagrees with the Examiner that the aforementioned phrase was not enabled in the patent application as filed, the phrase has currently been removed from the independent claims. Therefore, the Applicant requests that the Examiner withdraw the §112 rejection.

### **II. Rejection of Claims 1-3, 5-10, 12-17 and 19-21 under 35 U.S.C. §103**

The Examiner has rejected Claims 1-3, 5-10, 12-17 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,668,852 to Holmes ("Holmes") in view of: U.S. Patent No. 5,561,703 to Arledge ("Arledge") or U.S. Patent No. 5,692,038 to Kraus ("Kraus"). Newly amended independent Claims 1, 8 and 15 currently include the element that an ancillary information collector prompts a paging party to choose at least a portion of a party identification information from a database. The combination of Holmes and Arledge, or alternatively the combination of Holmes and Kraus, fails to teach or suggest this newly claimed element.

Holmes is directed to automatically providing information associated with a telephone caller to a paging system when the caller directs a call to a pager. (Column 1, lines 11-15). The associated information may include the caller's telephone number, however, the associated information may further include any information about the caller retrieved from a database search. (Column 4, lines 15-25). Such a database search can be based on the datum extracted from the incoming call, datum provided by the user, the intended pagers phone number, etc.. The system of Holmes, however, does not prompt a paging party to choose at least a portion of a party identification information from a database. Therefore, Holmes fails to teach or suggest this element.

Arledge and Kraus, either alone or in combination, do not cure the deficiency of Holmes. Specifically, neither Arledge nor Kraus teaches nor suggests that an ancillary information collector prompts a paging party to choose at least a portion of a party identification information from a database. While Arledge and Kraus may teach or suggest a priority list, and for that matter a priority list having a very different purpose and features than the priority list previously claimed, a teaching or suggestion of a priority list is far from a teaching or suggestion of an ancillary information collector prompting a paging party to choose at least a portion of a party identification information from a database.

Thus, Holmes, Arledge and Kraus, individually or in combination, fail to teach or suggest each and every element of independent Claims 1, 8 and 15 and, therefore, fail to establish a *prima facie* case of obviousness with respect to Claims 1, 8 and 15 and Claims dependent thereon. Accordingly, Claims 1-3, 5-10, 12-17 and 19-21 are not obvious, and thus the Applicant respectfully requests the Examiner withdraw the §103(a) rejection and issue allowance thereof.

### **III. Rejection of Claims 4-7, 11-14 and 18-21 under 35 U.S.C. §103**

The Examiner has rejected Claims 4-7, 11-14 and 18-21 under 35 U.S.C. §103(a) as being unpatentable over Holmes, Arledge and Kraus in view of: U.S. Patent No. 5,592,531 to Chen, U.S. Patent No. 5,940,740 to Aas or U.S. Patent No. 6,044,247 to Taskett for Claims 4, 11 and 18; Taskett or U.S. Patent No. 6,278,862 to Henderson for Claims 5, 12 and 19; Taskett or U.S. Patent No. 6,192,218 to Laufmann for Claims 6, 13 and 20; and U.S. Patent No. 5,742,668 to Pepe for Claims 7, 14 and 21.

As discussed above, the combination of Holmes, Arledge and Kraus does not teach or suggest the claimed element of an ancillary information collector prompting a paging party to choose at least a portion of a party identification information from a database, as recited in Claims 1, 8 and 15. Cheng, Aas, Taskett, Henderson, Laufmann and Pepe, as said in the office action, do not cure the deficiency of the combination of Holmes, Arledge and Kraus. Regarding Cheng, Aas and Taskett, each one has been cited to teach voice recognition of input from a paging party as an alternative to input by DTMF. More specifically, Cheng is directed to a selective call communication system that uses voice data entry, Aas is directed to a messaging system that allows verification whether a message has been sent, and Taskett is directed to a wireless paging system that facilitates connection by a subscriber to a call controller using a prepaid telephone card. However, while Cheng, Aas and Taskett may teach or suggest voice recognition of input from a paging party, as the Examiner asserts, this does not teach the claimed elements.

Regarding Henderson, Henderson has been cited to teach caller information with location and is directed to an improved communication system that more efficiently and accurately handles interactions with page-originating communicants. (Column 1, lines 59-64). Again, this does not

teach or suggest an ancillary information collector prompting a paging party to choose at least a portion of a party identification information from a database. Laufmann has been cited to teach caller information stored in a database (Examiner's Action, page 5) and is directed to transmitting and identifying predetermined calling party information as part of a messaging signal. (Abstract). Again, this does not teach or suggest, however, an ancillary information collector prompting a paging party to choose at least a portion of a party identification information from a database. Pepe has been cited to disclose various mobile communication subscribers (Examiner's Action, pages 5-6) and is directed to a personal communications internetwork that provides a subscriber with the ability to remotely control the receipt and delivery of wireless and wireline electronic text messages. (Abstract). Pepe teaches that the subscribers message receipt and delivery options are maintained in a database that the subscriber may update. (Abstract). These features do not teach or suggest an ancillary information collector prompting a paging party to choose at least a portion of a party identification information from a database.

Thus, Holmes, Cheng, Aas, Taskett, Henderson, Laufmann or Pepe, individually or in combination, fail to teach or suggest each and every element of independent Claims 1, 8 and 15 and, therefore, the cited combination of references fails to establish a *prima facie* case of obviousness for Claims 1, 8 and 15 and Claims dependent thereon. Accordingly, Claims 4-7, 11-14 and 18-21 are not obvious, and thus the Applicant respectfully requests the Examiner withdraw the §103(a) rejection and issue allowance thereof.

#### IV. Conclusion

In view of the foregoing amendment and remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-21.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in black ink, appearing to read "G. Parker", written over the printed name.

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